



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,127	01/12/2001	Chun-un Kang	Q61464	8900

7590 03/08/2004

SUGHRUE, MION, ZINN, MACKPEAK & SEAS, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037-3213

EXAMINER

DANG, KHANH NMN

ART UNIT	PAPER NUMBER
----------	--------------

2111

10

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/758,127

Applicant(s)

KANG ET AL.

Examiner

Khanh Dang

Art Unit

2111

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-95 is/are pending in the application.
- 4a) Of the above claim(s) 4-91, 93 and 95 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 92, and 94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 92 and 94 are rejected under 35 U.S.C. 102(e) as being anticipated by Bastiani et al.

At the outset, it is noted that similar claims will be grouped together to avoid repetition in explanation.

As broadly drafted, these claims do not define any step that differs from Bastiani et al. With regard to claims 92 and 94, Kawamura discloses an operation method of a portable personal device having facilities for storing and playing digital contents by control from a computer (host) through a serial or parallel cable, the method comprising the steps of: (a) receiving a request command from the computer (host) through a serial or parallel cable (from host to device through ASP); (b) sending from the portable

Art Unit: 2111

personal device (ASP device) through a serial or parallel cable a signal indicating that the portable personal device is ready to execute the request command to the computer (host), when the portable personal device (ASP device) is ready to execute the request command (ACK is now sent from device to host); (c) receiving an execution command (next packet is sent in response to ACK) from the computer (host) through a serial or parallel cable for executing the request command received in the step (a); and (d) executing the request command, when the execution command is received in the step (c), and then sending the result to the computer through a serial or parallel cable (ACK/status after the request executed without any error).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bastiani et al. in view of Kobayashi et al.

Bastiani et al., as explained above, discloses the claimed invention. However, Bastiani et al. does not disclose the use of a format conversion step to convert for facilitating interconnecting devices having different formats. Kobayashi et al. discloses

Art Unit: 2111

the use of a format conversion for facilitating interconnecting devices having different formats. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Bastiani et al. with a format conversion, as taught by Kobayashi et al., for the purpose of facilitating/enhancing the interconnectivity of Bastiani et al. with other devices having different formats. Note also that "packets" in Bastiani et al., as in any other conventional packets, include indicators for indicating a begin and end of data, length of data, start and content of command or status, and an indicator indicating an end of a transmission data. If the Applicants choose to challenge the fact that a "packets" includes indicators for indicating a begin and end of data, length of data, start and content of command or status, and an indicator indicating an end of a transmission data, supportive documents will be provided upon request.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bastiani et al. in view of Kawamura et al.

Bastiani et al., as explained above, discloses the claimed invention. However, Bastiani et al. does not disclose the use of a format conversion step to convert for facilitating interconnecting devices having different formats. Kawamura et al. discloses the use of a format conversion for facilitating interconnecting devices having different formats. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Bastiani et al. with a format conversion, as taught by Kawamura et al., for the purpose of facilitating/enhancing the interconnectivity of Bastiani et al. with other devices having different formats. Note also that "packets" in

Art Unit: 2111

Bastiani et al., as in any other conventional packets, include indicators for indicating a begin and end of data, length of data, start and content of command or status, and an indicator indicating an end of a transmission data. If the Applicants choose to challenge the fact that a "packets" includes indicators for indicating a begin and end of data, length of data, start and content of command or status, and an indicator indicating an end of a transmission data, supportive documents will be provided upon request.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bastiani et al. in view of Kagle et al.

Bastiani et al., as explained above, discloses the claimed invention. However, Bastiani et al. does not disclose the use of a format conversion step to convert for facilitating interconnecting devices having different formats. Kagle et al. discloses the use of a format conversion for facilitating interconnecting devices having different formats. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Bastiani et al. with a format conversion, as taught by Kagle et al., for the purpose of facilitating/enhancing the interconnectivity of Bastiani et al. with other devices having different formats. Note also that "packets" in Bastiani et al., as in any other conventional packets, include indicators for indicating a begin and end of data, length of data, start and content of command or status, and an indicator indicating an end of a transmission data. If the Applicants choose to challenge the fact that a "packets" includes indicators for indicating a begin and end of data, length of data, start

Art Unit: 2111

and content of command or status, and an indicator indicating an end of a transmission data, supportive document(s) will be provided upon request.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bastiani et al. in view of Kobayashi et al., as applied to claims 1 and 2 above, and further in view of the following.

The further difference between the claimed subject matter and that of Bastiani et al. is the use of a docking station. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Bastiani et al. with a docking station, since the Examiner takes Official Notice that the use of a docking station is old and well-known; and providing one to Bastiani et al. for the purpose of expanding the connecting capability of the device of Bastiani et al. to a plurality of peripherals only involves ordinary skill in the art. If the Applicants choose to challenge the fact that a "docking station" is old and well-known, supportive document(s) will be provided upon request.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bastiani et al. in view of Kawamura et al., as applied to claims 1 and 2 above, and further in view of the following.

The further difference between the claimed subject matter and that of Bastiani et al. is the use of a docking station. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Bastiani et al. with a docking

Art Unit: 2111

station, since the Examiner takes Official Notice that the use of a docking station is old and well-known; and providing one to Bastiani et al. for the purpose of expanding the connecting capability of the device of Bastiani et al. to a plurality of peripherals only involves ordinary skill in the art. If the Applicants choose to challenge the fact that a "docking station" is old and well-known, supportive document(s) will be provided upon request.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bastiani et al. in view of Kagle et al., as applied to claims 1 and 2 above, and further in view of the following.

The further difference between the claimed subject matter and that of Bastiani et al. is the use of a docking station. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Bastiani et al. with a docking station, since the Examiner takes Official Notice that the use of a docking station is old and well-known; and providing one to Bastiani et al. for the purpose of expanding the connecting capability of the device of Bastiani et al. to a plurality of peripherals only involves ordinary skill in the art. If the Applicants choose to challenge the fact that a "docking station" is old and well-known, supportive document(s) will be provided upon request.

Response to Arguments

Applicants' arguments filed 12/23/2003 have been fully considered but they are not persuasive.

At the outset, Applicants are reminded that claims subject to examination will be given their broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997). In fact, the "examiner has the duty of police claim language by giving it the broadest reasonable interpretation." *Springs Window Fashions LP v. Novo Industries, L.P.*, 65 USPQ2d 1862, 1830, (Fed. Cir. 2003). Applicants are also reminded that claimed subject matter not the specification, is the measure of the invention. Disclosure contained in the specification cannot be read into the claims for the purpose of avoiding the prior art. *In re Sporck*, 55 CCPA 743, 386 F.2d, 155 USPQ 687 (1986).

With this in mind, the discussion will focus on how the terms and relationships thereof in the claims are met by the references. Response to any limitations that are not in the claims or any arguments that are irrelevant and/or do not relate to any specific claim language will not be warranted.

The Bastiani et al. 35 USC 102(e) Rejection :

With regard to claim 92 (with claims 94 and 1-3 stand or fall together), Applicants argued that "Bastiani et al. do not disclose sending from the portable personal device through the serial or parallel cable a signal indicating that the portable personal device is ready to execute the request command to the computer, when the portable personal

Art Unit: 2111

device is ready to execute the request command. The Examiner asserts that the "ACK" handshake packet corresponds to this feature of the claim, but Applicant disagrees."

Contrary to Applicants' argument, in Bastiani, ACK indicates that the data packet was received without CRC errors over the data field and that the data PT was received correctly and the host or device has accepted the data. An ACK handshake is applicable only in transactions which data has been transmitted or where a handshake is expected. ACK's are issued in response to the receiver correctly receiving a data packet with the correct sequence number. ACK's can be returned by the host for device to host transactions and by a device for host to device transactions. ACK's are also issued in response to a device receiving a Reset or Heartbeat packet indicating that the Reset or Heartbeat packet was successful. In Bastiani et al., the HEARTBEAT packet is used to provide support for removable media devices. A device must respond to the HEARTBEAT packet with an ACK packet if the device is ready and there is no change in media status since the last status read. See Bastiani, at least column 43, lines 30-34.

The 103 Rejections:

Applicants did not separately argued against the rejections under 35 USC 103(a).

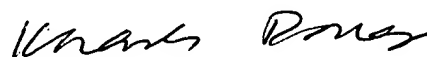
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 2111

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Khanh Dang at telephone number 703-308-0211.



Khanh Dang
Primary Examiner